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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Nikhil M. Deshpande

Title: PERSONAL ASSISTANCE SERVICE WITH INSTANT MESSAGING

Docket No.: 884.493US1

Filed: August 28, 2001

Examiner: Kimberly D Flynn

Serial No.: 09/940,755

Due Date: May 20, 2006 (Saturday)

Group Art Unit: 2152

MS Appeal Brief - Patents

Commissioner for Patents

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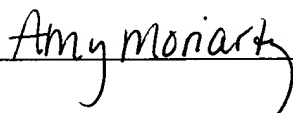
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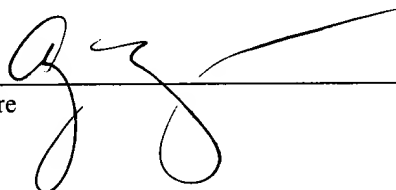
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(GENERAL)



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PATENT

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Title: PERSONAL ASSISTANCE SERVICE WITH
INSTANT MESSAGING

Assignee: Intel Corporation

Customer Number: 21186

REPLY BRIEF UNDER 37 C.F.R. § 41.41

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APPELLANT'S REPLY BRIEF

This Reply Brief is filed in response to the Examiner's Answer (hereinafter, the "Answer"), mailed March 20, 2006, and supplements the Appeal Brief filed by the appellant on December 14, 2005. Please charge any required additional fees or credit overpayments to Deposit Account 19-0743.

Grouping of Claims

The Examiner's Answer requested that the appellant include a statement of which claims stand or fall together. The following two separate groups of claims are selected, and are argued separately in the appellant's brief.

Claims 1-11 and 22-24 stand together for purposes of this appeal.

Claims 12-21 and 25 stand together for purposes of this appeal.

The appellant does not make any admission that any claim may not be argued in another forum as independently patentable from any other claim. Additionally, the appellant's grouping of claims above is provided for the purposes of this Reply Brief only.

Argument

Rejection under 35 USC §101

Claims 22 to 25 stand rejected under 35 USC §101. The appellant respectfully submits that claims 22 to 25 recite statutory subject matter under 35 USC §101.

In *AT&T*¹ the Federal Circuit stated that:

“we consider the scope of §101 to be the same regardless of the form – machine or process – in which a particular claim is drafted.”²

The Federal Circuit then cited language from *In re Alappat*³ and *State Street*⁴ in support of this principle. In this case, claims 22 to 25 were rejected solely because of the words “signal-bearing media” included in the preambles of each of claims 22-25, setting out the “form” of the claim. The Federal Circuit considers the “form” of the claim to be irrelevant to patentability under §101.

The standard of patentability under 35 USC §101 was set out by the Board of Patent Appeals and Interferences (hereinafter the Board) in *Ex parte Lundgren* citing *AT&T*:

“a process claim that applies a mathematical algorithm to ‘produce a useful, concrete, tangible result without pre-empting other uses of the mathematical principle, on its face comfortably falls within the scope of §101.’”⁵

The rejection in this case does not allege that claims 22 to 25 fail to “produce a useful, concrete, tangible result.” The words “useful, concrete, tangible result” do not appear in the rejection. In the words of the Board, “one would think there would be no more issues to be resolved under 35 USC §101.”⁶

In addition, claim 22 clearly indicates that the instructions can be read and executed by a processor to implement a statutory process as the preamble states. Claims 22 to 25 are therefore statutory in view of MPEP 2106.IV.B.1.

¹ *AT&T Corp. v. Excel Communications Inc.*, 50 USPQ2d 1447 (Fed. Cir. 1999).

² *AT&T*, 50 USPQ2d at 1451.

³ *In re Alappat*, 31 USPQ2d 1545 (Fed. Cir. 1994).

⁴ *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 47 USPQ2d 1596 (Fed. Cir. 1998).

⁵ *Ex parte Lundgren*, Appeal No. 2003-2088 (Bd. Pat. App. & Inter. 2005).

⁶ *Ex parte Lundgren*, Appeal No. 2003-2088 (Bd. Pat. App. & Inter. 2005).

The appellant respectfully submits that claims 22 to 25 recite statutory subject matter under 35 USC §101, and that claims 22 to 25 are in condition for allowance.

Rejection under 35 USC §103

With respect to motivation to combine, the Examiner's Answer newly cites Carey, column 1, lines 47-58, as evidence of an advantage that "it is less costly and it utilizes less bandwidth."⁷ The appellant's Appeal Brief argues that "this advantage accrues to text messages which are distinguished from instant messaging in the same paragraph of Carey."⁸ The Examiner's Answer has not identified sufficient evidence of a rationale for combining Joyce and Carey.

With respect to the reasonable expectation of success, the appellant established in the Appeal Brief that evidence must be shown from the prior art of a reasonable expectation of success to establish a *prima facie* case of obviousness.⁹

The Examiner's Answer cited Carey, column 1, lines 47-58, as evidence of a reasonable expectation of success, the same text cited as evidence of a motivation to combine Carey and Joyce. The Examiner's Answer refers to Carey's "intent"¹⁰ which has little to do with a reasonable expectation of success. The appellant respectfully submits that the Examiner's Answer has not provided separate evidence, but relies on one theory backed by one quote alone to establish both a motivation and a reasonable expectation of success.

A reasonable expectation of success is an element of a *prima facie* case of obviousness that is separate and distinct from the element of a motivation to combine, and the appellant respectfully submits that the Examiner's Answer has not provided evidence from the prior art of a reasonable expectation of success of the proposed combination of Joyce and Carey.

The Examiner's Answer also states:

"In predictable arts, the burden is on the applicant to show evidence that there is no reasonable expectation of success."¹¹

⁷ Examiner's Answer, page 6.

⁸ Appeal Brief, page 12.

⁹ MPEP 2143 citing *In re Vaeck*, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

¹⁰ Examiner's Answer, page 11.

¹¹ Examiners Answer, page 11.

The appellant is not aware of any case law that carves out such an exception for “predictable arts.” With respect to the burden, “the burden to rebut a rejection of obviousness does not arise until a *prima facie* case has been established.”¹²

The appellant respectfully submits that a *prima facie* case of obviousness against claims 1-25 has not been established in the final Office Action, and that claims 1-25 are in condition for allowance.

¹² *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

CONCLUSION

The appellant respectfully submits that the rejections of claims 1-25 under 35 U.S.C. §103 were erroneous, and that the rejection of claims 22-25 under 35 U.S.C. §101 was erroneous. Reversal of those rejections is respectfully requested, as well as the allowance of all the rejected claims.

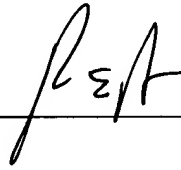
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Respectfully submitted,

NIKHIL M. DESHPANDE

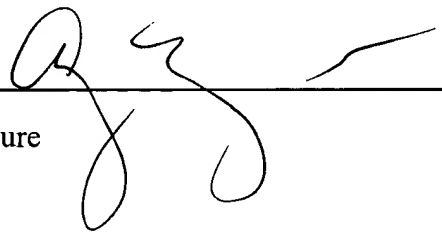
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Date 22 May 2006

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